

REMARKS

Claims 1-6 are all the claims pending in the application.

Claim 5 has been amended herein to further recite that the molar ratio of the isocyanate to oxetane at the time of the reaction is 1:0.90 to 1:1.10. Support for the amendment can be found in the specification at, for example, page 10, lines 16-23. Thus, no new matter has been added.

Entry of the Amendment is respectfully requested.

A. Response to Rejection of Claims 1-4

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 0867443 to Moszner et al. ("Moszner")¹ in view of U.S. Patent No. 6,166,100 to Hiwara et al. ("Hiwara") and U.S. Patent No. 6,953,862 to Musa ("Musa"). Office Action at page 2.

Applicants respectfully traverse for the following reasons.

Independent claim 1 is directed to an oxetane compound containing a (meth)acryloyl group, which is represented by formula (1), wherein R¹ represents a hydrogen atom or a methyl group, A represents -OR²- or a bond, R² represents a divalent hydrocarbon group which may contain an oxygen atom in the main chain, R³ represents a linear or branched alkylene group having 1 to 6 carbon atoms, and R⁴ represents a linear or branched alkyl group having 1 to 6 carbon atoms.

¹ Applicants note that the Examiner incorrectly cited Moszner as EP 0897443. Moszner has corresponding U.S. Patent Nos. 6,284,898 and 6,096,903 and Japanese Patent Publication No. JP-A-10-330485. In responding to the rejection, Applicants assumed the Examiner meant to cite to EP 0867443.

In response to this rejection, Applicants note that though an oxetane compound having both an oxetanyl group and a (meth)acryl group is improved in polymerizability, a problem remains in that, with its adhesiveness to other polymers or materials being poor, its practical properties are low. Accordingly, an object of the present invention is to provide a novel oxetane compound which has high practical properties, excellent in copolymerizability with compounds containing (meth)acryloyl groups. *See* present specification at page 2, line 31 to page 3, line 7.

The oxetane compound of the present invention is a compound represented by formula (I), wherein an (meth)acryloyl group (which imparts copolymerizability), urethane bond (which imparts adhesiveness) and an oxetanyl group (imparting cationical polymerizability) are bonded in this order.

The references do not anticipate or render obvious by any appropriate means, formula (1) of the present invention. In support of its rejection, the Office cannot take one portion of a compound from one reference and take a second portion of a compound from a second reference and claim the compound is obvious, as it has done here, where there is no support in either specification that the combination of the two portions would be desirable. The Office has failed to point out any such motivation to combine Moszner with Hiwara, and therefore the rejection is improper, as further discussed below.

Hiwara discloses in column 2, a compound having a structure wherein (meth)acryloyl group and oxetanylmethyl group are bound by an ester bond, which is different from a compound of the present invention in which a (meth)acryloyl group and an oxetanyl group are bound by a urethane group.

Meanwhile, Moszner discloses a compound wherein oxetanyl group is combined with triethoxysilyl group as a polymerizable group by a urethane group, however, the triethoxysilyl group taken as an example of a polymerizable group containing silicon aims at forming silicic acid condensates by hydrolytically condensing compounds of silicon and the like. Thus, the triethoxysilyl group disclosed in Moszner is different from the (meth)acryloyl group as presently claimed, which aims at imparting copolymerizability by radical polymerization.

Furthermore, in the invention of Moszner, replacing a compound wherein oxetanylalkylurethane group is bound to triethoxysilyl group with a compound having a structure of Hiwara, where the (meth)acryloyl group is bound to the oxetanylmethyl group by an ester bond, would not achieve the purpose of forming silicic acid condensates by hydrolytically condensing compounds of silicon and the like, as disclosed in Moszner. Accordingly, one having ordinary skill in the art would not have been motivated to substitute the compound in Moszner with the structure of Hiwara, as suggested by the Office. In any event, even if the compound disclosed in Hiwara, wherein (meth)acryloyl group is bound to the oxetanylmethyl group by an ester bond, was substituted into the compound disclosed in Moszner, it would not obtain the compound as presently claimed.

Thus, one having ordinary skill in the art would not be motivated to combine Moszner and Hiwara, nor would one have arrived at the present invention from those references, even further considering Musa.

For at least the above reasons, it is respectfully submitted that the present invention is patentable over, and nonobvious in view of, Moszner in view of Hiwara and Musa. Thus, withdrawal of the rejection of claims 1-4 is respectfully requested.

B. **Response to Rejection of Claims 5-6**

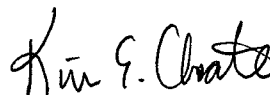
Claims 5-6 have been rejected under §103(a) as being unpatentable over the English abstract of Japanese Patent No. 11246541 to Mikito et al. ("Mikito"). Office Action at page 3.

Without commenting on the merits of the rejection, and in efforts to expedite prosecution of the present application, independent claim 5 has been amended as discussed above to additionally recite that the molar ratio of the isocyanate to oxetane at the time of the reaction is 1:0.90 to 1:1.10. Mikito fails to disclose a molar ratio of the isocyanate to oxetane compound as 1:0.90 to 1:1.10. As such, it is respectfully submitted that claims 5-6 are patentable over Mikito, and withdrawal of the rejection is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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